

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OLIFF & BERRIDGE, PLC  
P.O. Box 19928  
Alexandria, Virginia 22320  
Telephone: (703) 836-6400

Attorney Docket No.: JAO 34191

Date: September 26, 2000

Examiner: C. Tucker

Art Unit: 2766

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SEP 28 2000  
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log for  
CPA  
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FC 2700 MAIL ROOM

## BOX CPA

Director of the U.S. Patent and Trademark Office  
Washington, D.C. 20231

CONTINUED PROSECUTION APPLICATION TRANSMITTAL  
RULE 1.53(d)

Sir:

Transmitted herewith under 37 C.F.R. §1.53(d) is a request for filing a

☒ Continuation☐ Divisionalcontinued prosecution application of prior pending Application No. 08/976,579, filed November 24, 1997 (on or after June 8, 1995),For (Title): PAPER DOCUMENT SATCHELS

(Amended Title): \_\_\_\_\_

By (Inventors): James D. THORNTON et al.

1. ☒ Abandon said prior application as of the filing date accorded this application.
2. ☒ The filing fee is calculated below:

CLAIMS REMAINING IN THE APPLICATION AFTER  
ENTRY OF ANY PRELIMINARY AMENDMENT OR  
AMENDMENT UNDER 37 C.F.R. §1.116 NOTED BELOW

FOR:	NO. FILED	NO. EXTRA	RATE	FEE
BASIC FEE				\$ 690
TOTAL CLAIMS	27 - 20	= 7	x 18	\$126
INDEP CLAIMS	3 - 3	= 0	x 78	\$0
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS PRESENTED			+260	\$0
* If the difference is less than zero, enter "0".			TOTAL	\$816

3. ☒ Please charge Deposit Account No. 24-0037 in the amount of \$816, to cover the filing fee. The Director is hereby authorized to charge any other fees which may be required to complete this filing, or credit any overpayment, to deposit account No. 24-0037. Two duplicate copies of this form are attached.

DEPOSIT ACCOUNT USE  
AUTHORIZATION  
Please grant any extension  
necessary for entry;  
Charge any fee due to our  
Deposit Account No. 24-0037

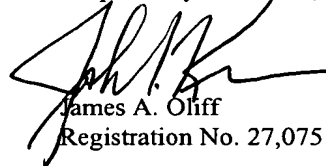
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690.00 CH  
126.00 CH01 FC:131  
02 FC:103

4. ☐ Cancel in this application claims \_\_\_\_\_ of the prior application before calculating the filing fee. At least one independent claim is retained for filing purposes.
5. ☐ Please enter in the present application the Amendment Under 37 CFR §1.116 with any attachments filed on \_\_\_\_\_ in said prior application which was not entered therein.
6. ☐ Please suspend action on this CPA application for three months under 37 C.F.R. §1.103(b). Please charge **Deposit Account No. 24-0037** in the amount of \$130.00, to cover the suspension fee. The Director is hereby authorized to charge any additional fees or credit any overpayment associated with this communication to **Deposit Account No. 24-0037**.
7. ☐ Priority of foreign application(s) No. \_\_\_\_\_ filed \_\_\_\_\_ in \_\_\_\_\_ is claimed under 35 U.S.C. §119.  
☐ The certified copy was filed in prior Application No. \_\_\_\_\_ on \_\_\_\_\_.  
☐ A certified copy of the above corresponding foreign application is filed herewith.
8. ☐ Priority of U.S. Provisional Application(s) No. \_\_\_\_\_ filed \_\_\_\_\_ is claimed under 35 U.S.C. §119.  
☐ The specification already includes a reference to the provisional application(s).  
☐ Amend the specification by inserting before the first line the sentence:  
--This nonprovisional application claims the benefit of U.S. Provisional Application(s) No. \_\_\_\_\_ filed \_\_\_\_\_.--
9. ☐ The prior application is assigned of record to \_\_\_\_\_ recorded at Reel \_\_\_\_\_, Frame \_\_\_\_\_.
10. ☒ The power of attorney in the prior application is to James A. Oliff, Registration No. 27,075, William P. Berridge, Registration No. 30,024, Kirk M. Hudson, Registration No. 27,562, Thomas J. Pardini, Registration No. 30,411, Edward P. Walker, Registration No. 31,450, Robert A. Miller, Registration No. 32,771, Mario A. Costantino, Registration No. 33,565, Stephen J. Roe, Registration No. 34,463, and/or John E. Beck, Registration No. 22,833.
11. ☒ Address all future communications to:  
**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**
12. ☒ A Preliminary Request for Reconsideration is enclosed.
13. ☐ An Information Disclosure Statement is enclosed.

Respectfully submitted,

  
James A. Oliff  
Registration No. 27,075

John S. Kern  
Registration No. 42,719

JAO:RSE/jam

#9  
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for  
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**PATENT APPLICATION RECEIVED**

Xerox Reference No.: SEP 28 2000  
D/97427

TC 2700 MAIL ROOM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

James D. THORNTON et al.

Application No.: 08/976,579

Filed: November 24, 1997

For: PAPER DOCUMENT SATCHELS



Group Art Unit: 2766

Examiner: C. Tucker

Docket No.: JAO 34191

PRELIMINARY REQUEST FOR RECONSIDERATION

Director of the U.S. Patent and Trademark Office  
Washington, D.C. 20231

Sir:

Prior to the initial examination of the Continued Prosecution Application (CPA) filed on September 26, 2000, reconsideration of the above-identified application is respectfully requested. Claims 1-27 remain pending in this application.

Claims 1-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lamming (U.S. Patent No. 5,862,321) in view of Zdybel (U.S. Patent No. 5,486,686). Applicants respectfully traverse the rejection.

The Intellectual Property and Communications Omnibus Reform Act of 1999, enacted November 29, 1999, amended 35 U.S.C. §103(c) to add that subject matter which qualify as prior art only under §102(e) may not be applied to establish obviousness under 35 U.S.C. §103 when the subject matter and the claimed invention were, at the time the invention was made, owned by the same entity or subject to an obligation of assignment to

the same entity. This change applies to any patent application filed on or after November 29, 1999.

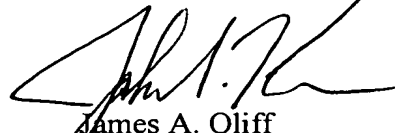
Accordingly, Lamming, Zdybel and the present application were commonly assigned to Xerox at the time the above-identified application was filed. Furthermore, the CPA filed herewith is filed after the November 29, 1999 effective date. Accordingly, Lamming and Zdybel cannot be used as prior art against the above-identified application under §102(e)/§103(a). Thus, the above rejections under 35 U.S.C. §103(a) are improper and should be withdrawn.

Therefore, Applicants assert that independent claims 1, 10 and 19 define patentable subject matter. Claims 2-9, 11-18 and 20-27 depend from independent claims 1, 10 and 19, respectfully, and therefore, also define patentable subject matter. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn

In view of the foregoing remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-27 are earnestly solicited.

Should the Examiner believe that anything further is desirable to place the application in even better condition for allowance, the Examiner is invited to contact the Applicants' attorney at the telephone number listed below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

John S. Kern  
Registration No. 42,719

JAO:RSE/jam

Date: September 26, 2000

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